

REMARKS

The foregoing amendment and the following arguments are provided generally to impart precision to the claims, by more particularly pointing out the invention, rather than to avoid prior art.

Claims 1-26 were rejected. New claims 27 and 28 are added. Claims 1-28 are pending. Support for the amendments is found in the specification, the drawings, and in the claims as originally filed. No new matter has been added.

Rejections Under 35 U.S.C. §102(e)

Claims 1, 11, 21-23 and 26 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Application Publication No. 2002/0003867 (hereinafter "Rothschild").

In Rothschild, a customer uses voice commands to select the menu of options provided by a menu system until a particular merchant is selected. See, for example, paragraph [0012], "Menu Tree" of Fig. 2 and the tree of menu options in Fig. 1 in Rothschild. A customer of the system of Rothschild selects one option a time from a list of menu items using voice menu of options. By going through the tree of menu options the customer reaches one merchant, to which the system routes the call of the customer.

The system of Rothschild is different from what is recited in independent claims 1, 11 and 21. Claim 1, for example, recites "*searching* a service provider database according to the one or more search criteria to generate a list of one or more service providers". The system of Rothschild relies on the menu system for navigation. A customer of Rothschild says the desired items of the menu options but not search criteria. Since Rothschild does not teach or suggest a search as recited in the claim, Rothschild does not anticipate claim 1.

Thus, Rothschild does not anticipate claims 1, 11 and 21 and their dependent claims at least for the above discussed reasons.

Further, claim 27 recites:

27. (New) The method of claim 1, wherein the field of service desired by the user does not correspond to one or more selections according to a menu system; and said searching the service provider database is not based exclusively on one or more selections according to a menu system.

In Rothschild, the navigation is based on the menu system. In Rothschild, the field of service desired by the user is selected according to a menu system. In claim 27, the “field of service desired by the user” does not correspond to selections according to a menu system. Thus, Rothschild does not anticipate claim 27.

Further, claim 26 recites:

26. (Previously Presented) The system of claim 21, wherein the interface comprises:
a wireless communications network interface;
wherein at least one of the one or more search criteria is not a selection from an option list.

The Office Action asserted that location is not selected from an option list in Rothschild. Application respectfully disagrees. According to the description in the abstract of Rothschild, for example, the caller says the location after saying the menu option “food” and before saying the menu option “Chinese”. It appears that the location is also specified in a way similar to the option of “food” and the option of “Chinese”. There is no indication that the location is not selected from an option list in Rothschild.

Further, “location” does not correspond to “field of service desired”. In claim 27, the “field of service desired by the user” does not correspond to selections according to a menu system.

Thus, Rothschild does not anticipate claims 26 and 27.

Further, claim 28 recites:

28. (New) The method of claim 1, wherein the one or more search criteria include an aspect of desired expertise of service providers for the field of service that is provided over the audio transmission medium, the aspect of desired expertise being not an a selection from an option list.

Rothschild does not show the features recited in claim 28.

Rothschild does not show how the records about the restaurants are obtained. Specifically, Rothschild does not show “*a request* from a service provider of a field of service for inclusion in the service provider database, ... the record including provider information contained in the *request*”. Thus, the rejection of claim 23 under 35 U.S.C. §102(e) is improper.

Rejections Under 35 U.S.C. §103(a)

Claims 9 and 19 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rothschild in view of U.S. Patent No. 6,658,389 (hereinafter "Alpdemir"). Applicant respectfully disagrees.

In Alpdemir, a consumer user calls back *later* in a separate call to provide feedback. For example, Alpdemir shows

“a consumer user having been referred to a restaurant using inventive system can later call in using a toll-free or free local phone number and provide feedback, such as in the form of a rating, relative to their experience.” (Col. 11, lines 64-67, Alpdemir).

An ordinary person understands that a consumer does not have sufficient experience with the restaurant immediately after a conversation over the phone. It takes time to visit the restaurant before one may provide meaningful feedback about a restaurant. It typically takes a long period of time after the conversation with someone at the restaurant and before the consumer calls back to provide the feedback. Further, after spending a few hours in the restaurant, the consumer may not call back at all. However, claim 9 recites:

9. (Original) The method of claim 1, wherein following the connecting the user with the selected service provider, the method further comprises: once the live conversation between the user and the selected service provider is complete, prompting the user for a quality of service rating for services rendered by the service provider; and recording the service rating provided by the user in the service provider database.

The description of Alpdemir and Rothschild does not have any indication of “*once* the live conversation between the user and the selected service provider *is complete, prompting* the user for a quality of service rating for services rendered by the service provider”. Thus, even if Alpdemir and Rothschild were combined, the resulting system would be different from what is claimed in claim 9. The combined system would not prompt the user in a way recited in the claim. Thus, without admitting the propriety of combining Rothschild and Alpdemir in a way presented in the Office Action, Applicant respectfully submits that claims 9 and 19 are patentable over the combination of Rothschild and Alpdemir.

Claims 2, 7, 8, 10, 12, 17, 18, 20, and 25 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rothschild in view of U.S. Patent No. 5,901,214 (hereinafter "Shaffer"). Applicant respectfully disagrees.

In rejecting claim 2, the Office Action asserted that “It would be obvious of one of ordinary skill in the art at the time of the invention to combine the system of Rothschild with the method of Shaffer because both systems make use of voice recognition systems” (the third paragraph on Page 9 of the Office Action). Applicant respectfully submits that “both systems make use of voice recognition systems” is not a proper motivation or suggestion to make use of “a Dual Tone Multi-Frequency (DTMF) decoder”. The Office Action failed to specify how the combined system might work. The Office Action failed to specify why the Dual Tone Multi-Frequency (DTMF) decoder would be needed in the system of Rothschild in view of Shaffer. Furthermore, the combined description of Rothschild and Shaffer does not show any indication

of “a keypad entry of a search criterion” in a way recited in claim 2. Thus, the withdrawal of the rejection for claim 2 is respectfully requested.

Claims 7, 8, 10, 12, 17, 18 and 20 were rejected using the same motivation that was utilized in the rejection of claim 2. Since the motivation presented in the Office Action for the rejection of claim 2 is invalid, the rejections for claims 7, 8, 10, 12, 17, 18 and 20 are also improper.

In rejecting claim 25, the Office Action asserted that “The same motivation that was utilized in the rejection of claim 25, applies equally as well to claim 25”. Applicant respectfully submits that this is circular reasoning. There is no valid motivation presented in the rejection of claim 25.

Claims 3-6, 13-16 and 24 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rothschild. Applicant respectfully disagrees. In rejecting claims 3-6, 13-16 and 24, without presenting any evidence the Office Action merely asserted that it would have been obvious. The conclusive assertions are not evidence, which is required for factually supporting any *prima facie* conclusion of obviousness. Thus, the rejections of claims 3-6, 13-16 and 24 are improper.

MPEP (2141) provides that “Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case.” MPEP (2142) provides that “The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” According to MPEP (2141),

“When applying 35 U.S.C. 103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined.” (MPEP 2141)

“The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” (MPEP 2142)

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.” (MPEP 2142)

“To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Applicant respectfully submits that the Office Action failed to provide a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. Further, in rejecting claims 3-6, 13-16 and 24, the Office Action failed to provide factually support for the prima facie conclusion of obviousness.

Thus, the withdrawal of the rejections under 35 U.S.C. §103(a) is respectfully requested.

Double Patenting Rejections

Claims 1, 3-6, 9, 11, 13-16, 19 and 21-26 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 and 18-28 of U.S. Patent No. 6,636,590. Applicant respectfully disagrees.

The Office Action asserted that the limitation of “when the voice request includes a field of service desired by the user, providing the user with a list of one or more service providers stored in a service provider database which match the field of service desired by the user” that is recited in claim 1 of U.S. Patent No. 6,636,590 corresponds to the limitation of “searching a service provider database according to the one or more search criteria to generate a list of one or more service providers” that is recited in claim 1 of the present application. Applicant respectfully disagrees.

The limitation of “when the voice request includes a field of service desired by the user, providing the user with a list of one or more service providers stored in a service provider database which match the field of service desired by the user” that is recited in claim 1 of U.S. Patent No. 6,636,590 does not specify how the “list of one or more service providers” is generated. Claim 1 of U.S. Patent No. 6,636,590 does not specify the operation of “searching a service provider database ...”.

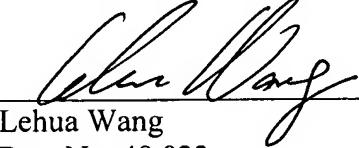
Since the differences between the claims of the present application and claims 1-15 and 18-28 of U.S. Patent No. 6,636,590 are more than the differences between “voice” and “audio form”, the withdrawal of the double patenting rejections is respectfully requested.

CONCLUSION

It is respectfully submitted that all of the Examiner's objections have been successfully traversed and that the application is now in order for allowance. Accordingly, reconsideration of the application and allowance thereof is courteously solicited.

Respectfully submitted,

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